

## **REMARKS**

Claims 22-24, 26-28, 30-32 and 34-51 were pending in this application. In order to expedite prosecution and without conceding to the propriety of the rejections, claims 23 and 24 have been canceled without prejudice to Applicants' right to pursue the subject matter of the canceled claims in a related application(s). In view of the cancellation of claim 23, dependent claims 26, 30, 34-37 and 49 have been amended to delete their dependency from claim 23. Further, Applicants have cancelled withdrawn claims 38-48, 50 and 51, without prejudice to Applicants' right to pursue the subject matter of the canceled claims in a related application(s). Applicants note that the Examiner incorrectly stated that claim 49 was withdrawn as being drawn to a method different in scope than the invention currently under examination. Claim 49, as amended, is directed to a method of treating colon cancer, an invention which is under examination in this application. The amendments are fully supported by the specification of the present application and do not constitute new matter. Upon entry of this Amendment, claims 22, 26-28, 30-32, 34-37 and 49 will be pending and under examination.

The amendments and remarks made herein place the application into condition for allowance or at a minimum reduce the issues on appeal. Accordingly, Applicants respectfully request that the amendments and remarks made herein be entered into the record of the application and fully considered by the Examiner.

### **1. INTERVIEW SUMMARY**

Applicants thank Examiners Gitmor and Srivastava for granting the telephonic interview with Applicants' attorneys, Nikolaos C. George and Jennifer Chheda, on July 27, 2006 to discuss the outstanding Office Action in the present application. In particular, Applicants' attorneys and Examiners Gitmor and Srivastava discussed the priority statements and enablement rejections in the Office Action. Examiners Gitmor and Srivastava agreed with Applicants' attorneys that Applicants were entitled to the priority benefit of International application No. PCT/US00/25733, filed September 20, 2000. Examiners Gitmor and Srivastava informed Applicants' attorneys that they would consider Applicants' written response to the Office Action.

**2. ENTITLEMENT TO PRIORITY**

In the Office Action, the Examiner contends that Applicants are not entitled to the priority benefit of U.S. provisional application Serial No. 60/155,018, filed September 21, 1999 and International application No. PCT/US00/25733, filed September 20, 2000. Applicants note that the present application is a national stage application of International application No. PCT/US00/25733, filed September 20, 2000. Thus, the specification of International application No. PCT/US00/25733 is, and, in fact, must be, identical to the specification of the present application. Further, Applicants note that the Declaration and Power of Attorney filed in the USPTO on August 15, 2002 in connection with the present application recites that the application claims priority to U.S. application Serial No. 60/155,018, filed September 21, 1999 and International Application No. PCT/US00/25733, filed September 20, 2000. Accordingly, as acknowledged by Examiners Gitmor and Srivastava in the interview conducted on July 27, 2006, the present application is entitled to the priority benefit of September 20, 2000.

**3. THE REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, SHOULD BE WITHDRAWN**

Claims 23, 24, 26-28, 30-32 and 34-37 are rejected under 35 U.S.C. § 112, first paragraph, as not enabled for their full scope by the specification. Applicants acknowledge that the Examiner recognizes that the specification enables, *inter alia*, a method to treat colon cancer via administering a composition comprising the recited orange peel extract polymethoxylated flavones (July 27, 2005 Office Action, page 4, paragraph 14 and April 20, 2006 Final Office Action, page 4, paragraph 13). Applicants note that pending claim 22 and dependent claims 26-28, 30-32, 34-37 and 49 are directed to such a method. The Examiner contends, however, that the specification does not reasonably enable methods for preventing colon cancer via administering a composition comprising the recited orange peel extract polymethoxylated flavones.

As previously argued in the responses filed on January 27, 2006 and May 11, 2005, Applicants respectfully assert that the specification coupled with information known to the skilled artisan as of the effective filing date of the present application would have provided sufficient guidance to enable one of skill in the art to practice the claimed methods of preventing colon cancer without undue experimentation. However, in order to expedite prosecution and without conceding to the propriety of the rejection, Applicants have canceled

claims 23 and 24, directed to methods of preventing colon cancer, and amended claims 26, 30, 34-37 and 49 so that they no longer depend from canceled claim 23. Accordingly, the rejection under 35 U.S.C. § 112, first paragraph, for lack of enablement is moot and should be withdrawn.

**4. THE PROVISIONAL DOUBLE PATENTING  
REJECTION SHOULD BE WITHDRAWN**

Claims 22-24, 26-28, 30-32 and 34-37 are provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 39, 43, 63, 71 and 72 of co-pending U.S. patent application Serial No. 09/992,860 (hereinafter "the '860 application").

Applicants note that the filing of this response should result in the withdrawal of the only other rejection of this application, namely the rejection under 35 U.S.C. § 112, first paragraph. Applicants also note that the '860 application was filed after the present application and is still pending. According to MPEP § 1490, V, D, page 1400-105 of Rev. 3, of the August 2005 MPEP, "[i]f the [obvious-type double patenting] rejection is the only rejection remaining in the earlier filed of the two pending applications, (but the later-filed is rejectable on other grounds), the examiner should then withdraw the rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer." Therefore, Applicants respectfully request that the present application be allowed to issue. The need to file a terminal disclaimer will be assessed in the '860 application.

**CONCLUSION**

Applicants believe that the present claims meet all the requirements for patentability. Entry of the foregoing amendments and remarks into the file of the application is respectfully requested. Withdrawal of all rejections and consideration of the amended claims are requested.

If any issues remain, the Examiner is urged to telephone the undersigned.

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Respectfully submitted,

Laura A. Coruzzi 30,742  
Laura A. Coruzzi (Reg. No.)

**JONES DAY**  
222 East 41st Street  
New York, New York 10017  
(212) 326-3939

- 6 - By: Jennifer J. Chheda  
Reg No. 46,617